



Docket No.: M4065.0573/P573-B
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:
David C. Feldmeier et al.

Application No.: 10/645,604 Confirmation No.: 8591

Filed: August 22, 2003 Art Unit: 2186

For: PARTIALLY ORDERED CAMS USED IN
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APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. § 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is pursuant to 37 C.F.R. § 41.41 and is responsive to the Examiner's Answer mailed October 17, 2005 in connection with the appeal from the final rejection of claims 56-87 mailed March 3, 2005 in the above-identified U.S. patent application.

The Examiner's Answer and the underlying Final Rejection of claims 56-87 are based on the argument that Mr. Feldmeier's declaration under 1.132 ("the Feldmeier Declaration," attached as Exhibit 3 in Appendix B in the Appeal Brief), standing alone, does not represent a satisfactory showing of inventorship sufficient to disqualify Music Semiconductor Application Note AN-N22 "A Method* For Fast IPv4 CIDR Address

Translation and Filtering Using the MUSIC WidePort LANCAM, LANCAM, and LANCAM 1st Family," dated January 1998 (the "LANCAM Publication") (attached as Exhibit 1 in Appendix B of the Appeal Brief) and Music Semiconductor Application Note AN-N25 "Fast IPv4 And IPv4 CIDR Address Translation and Filtering Using the MUAC™ Routing Coprocessor (RCP)*," dated January 1998 (the "MUAC Publication") (attached as Exhibit 2 in Appendix B of the appeal brief) as prior art under 35 U.S.C. §102(a). This argument runs counter to the MPEP and to the case law.

ARGUMENT

A. *In re Katz* is the Applicable Standard

Mr. Feldmeier's declaration under 1.132, standing alone, represents a satisfactory showing of inventorship in the absence of evidence to the contrary. *In re Katz*, 687 F.2d 450, 455-456 (CCPA 1982); MPEP 710.10. In *Katz*, the CCPA overturned a decision by the Board of Patent Appeals and Interferences in which the *only* evidence presented by the appellant to overcome the outstanding rejection was a declaration under 1.132 by the applicant Katz affirming that the subject matter of the cited reference relevant to the claims was derived from Katz himself. *Id.* The CCPA held that this uncontradicted declaration provided "a clear alternative conclusion to the . . . board's inference." *Id.* at 455. Relying on the declaration alone, the CCPA agreed that "Appellant's explanation is, thus, consistent not only with the content of the article, but with the nature of the publication," and held that "[o]n the record here, the board should not have engaged in further speculation as to whether appellant's view was shared by his co-authors but rather should have accepted" Katz's sworn statements in the absence of contrary evidence. *Id.* The Examiner's Answer argues that a higher standard should apply in this case, but this argument is not supported by the case law¹.

¹ The Examiner's Answer's argument is more reminiscent of Judge Miller's *Katz* dissent, which argued, unsuccessfully, that because the Katz declaration did not provide "a recitation of facts to support [his]

MPEP 716.01(c)², heavily relied on in the Examiner's Answer, is fully consistent with Appellant's arguments, with MPEP 716.10 and with the *Katz* decision.

B. The Feldmeier Declaration Alone is Sufficient to Overcome the Rejection

The Examiner's Answer backs down from the Final Rejection's assertion that the 1.132 declaration is not evidence. It revises its position to state that "to be of probative value, any objective evidence should be supported by actual proof," MPEP 716.01(c). However, MPEP 716.01(c) goes on to state that, generally, "an affidavit or declaration which states only conclusions may have some probative value." *Id.* Although "such an affidavit may have little weight when considered in light of all the evidence of record in the application," in the specific context of an *uncontradicted* declaration of inventorship under 1.132, and where the Examiner's Answer has presented no other "evidence of record" to weigh against the declaration, such an declaration is sufficient to overcome a 102(a) or (e) rejection. *Katz*, 687 F.2d at 455, MPEP 716.01(c), 716.10.

In *Katz*, the Board incorrectly upheld the Final Rejection because it "[did] not find [Katz's] declaration, standing alone, sufficient to establish that Katz is the sole inventor and thus remove the [] article as a reference" 687 F.2d at 453. The Board argued, similar to the Examiner's Answer here, that "Appellant's unsupported statements, even though under oath, do not convince us otherwise." *Id.* The CCPA reversed, holding that "[t]he Board should not have engaged in further speculation as

conclusions, . . . or a recitation of facts from which the PTO could conclude that [Katz's declaration was corroborated]," the onus should be on the appellant to "affirmatively clear the air." *Katz*, 687 F.2d at 458. This reasoning was rejected by the *Katz* majority. *Id.* at 455-456.

² The Examiner's Answer makes reference to MPEP 713.01(c) on page 9. This appears to be a typographical error; Appellant will assume that the Examiner's Answer is referring to MPEP 716.01(c).

to whether [Katz's] views were shared by his coauthors but rather should have accepted [Katz's declaration]." *Id.* at 455.

"[I]t is incumbent upon the inventors named in the application, . . . [in order] to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a *satisfactory showing by way of affidavit under 37 CFR 1.132* that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, . . . notwithstanding the authorship of the article." MPEP 716.01(c). *Katz* established that a declaration under 1.132 *alone* represents a satisfactory showing of inventorship in the absence of evidence to the contrary. 697 F.2d at 455 ("It was incumbent, therefore, on appellant to provide a satisfactory showing which would lead to a reasonable conclusion that he is the sole inventor . . . [Appellant's declaration] provides a clear alternative conclusion to the [Board's] conclusion.").

C. The Examiner's Answer's Argument that Katz is Distinguished from the Present Facts is Unpersuasive

The Examiner's Answer's argument dwells on the Katz's status as sole inventor to distinguish the present facts, which involve two inventors. However, the *Katz* court's discussion of sole inventorship is discussed only to confirm Katz's own sworn statement that he was the sole inventor and, thus, that Katz's assistant was not the source of the subject matter of the reference relevant to the claims. *Id.* The key point is not that the Katz was the *sole* inventor; rather, the key is that the sworn statement of an applicant is sufficient to establish that the material in a reference relevant to the claims is derived from the *applicants*, and not from *another*. MPEP 716.01(c).

It is instructive that the cited reference in *Katz* actually support a much stronger inference than do the LANCAM and MUAC references here. In *Katz*, not all

co-authors of the cited article were co-applicants. 687 F.2d at 455. The inference that the co-authors of the reference cited in *Katz* were also co-inventors was deemed reasonable by the CCPA, in the absence of contrary evidence. *Id.* Nevertheless, *Katz*'s uncontradicted declaration, that his coauthors "were students working under the direction and supervision of the inventor," alone was sufficient to overcome that inference in the absence of contradictory evidence. *Id.* at 455-456. Here, the Examiner's Answer does not point to any evidence that the subject matter of the LANCAM or MUAC references was invented by "another;" the Feldmeier Declaration attributes both authorship and inventorship to himself and his co-appellant, Mr. Arnold.

The Examiner's Answer argument relies on mere speculation and is not supported by any evidence. The lack of a byline is "consistent not only with the content of the article but with the nature of the publication," in this case, Music Semiconductors application notes, which are intended as technical references and do not typically attribute authorship to their actual authors. *Id.* at 455. The lack of a byline is not, in itself, evidence that the article contains subject matter deriving from the work of "another," or even that the article was authored by "another." Any inference that the Examiner's Answer attempts to draw on this point is squarely contradicted and overcome by Mr. Feldmeier's sworn declaration. Indeed, as discussed above, an uncontradicted declaration under 1.132 was sufficient to overcome this inference even when a byline *clearly recites other non-inventors as co-authors* of the disputed reference. *Id.*

D. Disclaimer is Inappropriate

The Examiner's Answer closes with the statement that "because declarant did not disclaim the publication as his own work, then such a statement (without further actual proof) begs further speculation." This argument is a non-sequitur – there is

nothing to disclaim. Mr. Feldmeier has made a sworn affirmative statement that he and Mr. Arnold are co-authors of the articles in question and that the material relevant to the claims were derived from the inventors. By definition, a declarant cannot “disclaim the publication as his own work;” a disclaiming affidavit is only appropriate to *exclude* a co-author from consideration as the source of particular subject matter.

CONCLUSION

Appellants respectfully submit that it is not the place of the Examiner’s Answer or the Board to engage in speculation, regardless of whether a statement “begs further speculation” or not. When “Appellant’s argument is . . . consistent not only with the content of the article but with the nature of the publication . . . the board should not [engage] in further speculation.” *Katz*, 687 F.2d at 455. The alternate theories presented in the Examiner’s Answer are not supported by evidence.

Despite the Examiner’s Answer’s insistence that “[n]o actual proof was submitted to make this declaration of any probative value,” Appellants respectfully submit that the Feldmeier Declaration has independent probative value which shifts the burden to the Examiner. The Examiner’s Answer has not offered any evidence to contradict any statement of the Feldmeier Declaration. Instead, the Examiner’s Answer is simply exploring alternate possibilities without presenting evidence which either confirms its speculations or contradicts Mr. Feldmeier’s declaration in any way.

Accordingly, Appellant respectfully submits that the LANCAM and MUAC references are not available as prior art under 35 U.S.C. §102(a). Reversal of the final rejection of claims 56-87 is respectfully requested.

Dated: December 19, 2005

Respectfully submitted,

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